

REMARKS

The Examiner objected to the specification.

The Examiner objected to claims 2, 12, 22 and 31.

The Examiner rejected claims 10, 20 and 30 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

The Examiner rejected claims 10, 20 and 30 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner rejected claims 1-36 under 35 U.S.C. § 101 for allegedly lacking the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. § 101.

The Examiner rejected claims 1, 2, 5, 9-11, 12, 15, 19, 20-22, 25, 29 and 30 under 35 U.S.C. § 102(e) as allegedly being anticipated by Myers Jr. *et al.*, U.S. Pat. 6,959,268.

The Examiner rejected claims 3, 4, 6-8, 13, 14, 16-18, 23, 24, 26-28 and 31-36 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Myers Jr. *et al.* as applied to claims 1, 2, 5, 9-11, 12, 15, 19, 20-22, 25, 29 and 30 above, in view of the *Microsoft Computer Dictionary Fifth Edition*, Microsoft Press, 2002, hereafter *Microsoft*.

Applicants respectfully traverse the specification objections, claim objections, § 112 rejections, § 101 rejections, § 102 rejections, and § 103 rejections with the following arguments.

Specification Objections

The Examiner argues: “The abstract of the disclosure is objected to because the phrase "A method computer system" is grammatically incorrect. It appears that a comma should separate "method" and "computer".”

In response, Applicant has amended the abstract to add a comma between “method” and “computer”.

The Examiner argues: “The specification is objected to because "extensible" is spelled inconsistently. In some places it is spelled "Extensible" as in [0068], "Extensible Stylesheet Language", and in other places it is spelled "eXtensible" as in [0079], "eXtensible Stylesheet Language". There is no apparent difference in meaning between the spellings, but the specification should be consistent”.

In response, Applicant has amended the specification to replace “Extensible” with “eXtensible” such that “Extensible” no longer appears in the specification.

The Examiner argues: “The use of the proprietary file extensions PDF and ZIP have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology. Although the use of proprietary information is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as proprietary information”.

In response, Applicant notes that PDF and ZIP are capitalized wherever they appear in the

specification. Furthermore, Applicant has amended the specification add generic terminology following the first appearance of PDF and ZIP in the specification.

The Examiner argues: “The Summary of the Invention is objected to because it is simply a recitation of the claims. This is not appropriate. See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.”

In response, Applicant respectfully contends that “The Summary of the Invention” recites the independent claims exactly and is therefore directed toward the invention rather than the disclosure as a whole, and is also in conformity with the requirements for “The Summary of the Invention” stated in MPEP § 608.01(d).

Therefore, Applicant respectfully requests that the objections to the specification be withdrawn.

Claim Objections

The Examiner objected to claims 2, 12, 22 and 31.

The Examiner argues: "As per claims 2, 12, 22, and 31, the specific limitation clauses should be separated by semicolons as in claims 1, 11, and 21."

In response, Applicant has amended claims 2, 12, 22, and 31 such that the specific limitation clauses are separated by semicolons as in claims 1, 11, and 21.

The Examiner argues: "As per claim 12, the punctuation after the phrase, "The computer system of claim 11,:" is incorrect. To be consistent with the other claims it should be just the comma."

In response, Applicant has amended claim 12 to delete : after the comma.

The Examiner argues: "As per claim 31, the phrase, "comprising package list frame" is grammatically incorrect. It appears to need an article before "package"."

In response, Applicant has amended claim 31 to insert "a" before "package".

Therefore, Applicant respectfully requests that the objections to claims 2, 12, 22 and 31 be withdrawn.

35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 10, 20 and 30 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

The Examiner argues: "Claims 10, 20, and 30 recite the limitation, "applying the presentation metadata to the additional technical metadata and the business metadata to generate the information catalog". The specification does not appear to describe how the "information catalog" is generated using "additional technical metadata" when it has already been generated a first time."

In response, Applicant has amended claims 10, 20 and 30 such that the "information catalog" is not generated using "additional technical metadata" when it has already been generated a first time.

Therefore, Applicant respectfully requests that the rejection of claims 10, 20 and 30 under 35 U.S.C. § 112, first paragraph be withdrawn.

35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 10, 20 and 30 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner argues: "Claims 10, 20, and 30 recite the limitation, "applying the presentation metadata to the additional technical metadata and the business metadata to generate the information catalog". However, the "information catalog" has already been generated in claims 1, 11, and 21."

In response, Applicant has amended claims 10, 20 and 30 such that a step of "applying the presentation metadata to the additional technical metadata and the business metadata to generate the information catalog" is not performed after the "information catalog" has already been generated.

Therefore, Applicant respectfully requests that the rejection of claims 10, 20 and 30 under 35 U.S.C. § 112, second paragraph be withdrawn.

35 U.S.C. § 101

The Examiner rejected claims 1-36 under 35 U.S.C. § 101 for allegedly lacking the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. § 101.

The Examiner argues: “Claims 1-36 lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. There also does not appear to be any tangible result of the data manipulation in the claims. Further, they are clearly not a combination of chemical compounds to be a composition of matter. Accordingly, the claims do not appear to contain a useful result. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*... For example, in claims 1, 11, and 21, "accessing" and "applying" do not generate a tangible result.”

In response, Applicants have amended claims 1, 11, and 21 to add the following tangible result step: “displaying, on an output device for an end user, a graphical interface representing the generated information catalog”.

The Examiner further argues: “As per claim 31, simply disclosing a "graphical interface" does not require that there be any tangible output to the user. Specifically, just because the "graphical interface" is "adapted to being navigated" by a user does not require that it is navigated by a user. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 138. Further, having

"selectable" elements does not mean that they actually are selected."

In response, Applicants have amended claim 31 to replace "adapted to" and "selectable" language with means plus function language, which Applicant believe overcomes the Examiner's basis for rejecting claim 31.

Therefore, Applicant respectfully requests that the rejection of claims 1-36 under 35 U.S.C. § 101 be withdrawn.

35 U.S.C. § 102(e)

The Examiner rejected claims 1, 2, 5, 9-11, 12, 15, 19, 20-22, 25, 29 and 30 under 35 U.S.C. § 102(e) as allegedly being anticipated by Myers Jr. *et al.*, U.S. Pat. 6,959,268.

Applicants respectfully contend that Myers Jr. does not anticipate claims 1, 11, and 21, because Myers Jr. does not teach each and every feature of claims 1, 11, and 21.

As a first example of why Myers Jr. does not anticipate claims 1, 11, and 21, Myers Jr. does not teach the feature: “accessing technical metadata from a data warehouse, said technical metadata being associated with data used by computer applications, said computer applications supporting business processes of the business model”.

With respect to the aforementioned feature in the first example, the Examiner argues: “See e.g. Fig. 4 where, see Brief Summary par. 20, “At the base of the CEE is an object oriented database managing an associative object model (product model) for providing a persistent understanding of product and program information, assets and tools available in the enterprise””.

In response, Applicant respectfully contends that the preceding citation by the Examiner is totally silent about metadata of any kind and is most certainly silent about technical metadata. The preceding citation by the Examiner is totally silent about accessing technical metadata from a data warehouse. The preceding citation by the Examiner is totally silent about the technical metadata being associated with data used by computer applications. The preceding citation by the Examiner is totally silent about the computer applications supporting business processes of the business model.

As a second example of why Myers Jr. does not anticipate claims 1, 11, and 21, Myers Jr.

does not teach the feature: “accessing business metadata from a first source outside of the data warehouse, said business metadata comprising relationships between the business processes and the computer applications, said business metadata further comprising relationships between the computer applications and the technical metadata”.

With respect to the aforementioned feature in the second example, the Examiner argues: “See e.g. Fig. 2 where, see Detailed Description par. 6, "The information transformation services layer 211 acts as a bidirectional link between the user interface and the populated CEE database" and Fig. 4 where Tools 402 and 404 access "data" in "database 407"”.

In response, Applicant respectfully contends that the preceding citation by the Examiner is totally silent about metadata of any kind and is most certainly silent about business metadata. The preceding citation by the Examiner mentions only “data” and is totally silent as to “metadata”. The preceding citation by the Examiner is totally silent about accessing business metadata from a first source outside of the data warehouse. The Examiner has not identified the data warehouse in Myers Jr. and therefore has not explained how the preceding citation teaches accessing business metadata from a first source outside of the data warehouse. The preceding citation by the Examiner is totally silent about business metadata comprising relationships between the business processes and the computer applications. The preceding citation by the Examiner is totally silent about the business metadata further comprising relationships between the computer applications and the technical metadata.

As a third example of why Myers Jr. does not anticipate claims 1, 11, and 21, Myers Jr. does not teach the feature: “accessing presentation metadata from a second source outside of the

data warehouse, said second source being independent of the first source, said presentation metadata specifying a presentation format of the technical metadata and business metadata”.

With respect to the aforementioned feature in the third example, the Examiner argues: “See e.g. Detailed Description par. 3, “members interact with the CEE through familiar web interfaces and engineering tools with the presentation structured for the appropriate domain” and Fig. 6, “ClientSide” layer 601.”

In response, Applicant respectfully contends that the preceding citation by the Examiner is totally silent about metadata of any kind and is most certainly silent about presentation metadata. The preceding citation by the Examiner is totally silent about accessing presentation metadata from a second source outside of the data warehouse. The preceding citation by the Examiner is totally silent about the second source being independent of the first source. The preceding citation by the Examiner is totally silent about the presentation metadata specifying a presentation format of the technical metadata and business metadata.

As a fourth example of why Myers Jr. does not anticipate claims 1, 11, and 21, Myers Jr. does not teach the feature: “applying the presentation metadata to the technical metadata and the business metadata to generate the information catalog, said information catalog comprising the technical metadata and the business metadata in accordance with the presentation format specified by the presentation metadata”.

With respect to the aforementioned feature in the fourth example, the Examiner argues: “See e.g. Fig. 7 where, see Detailed Description par. 35, “the tabs. 30 and buttons 31 at the top of the page represent a two-level hierarchical view of the information structure. The tabs 30

represent high level categories. Each tab has a set of buttons 31 or menus providing the next lower level breakdown. The "home" tab 32 contains some of the most basic information categories, such as the "process page" 33, as shown in the body frame"".

In response, Applicant respectfully contends that the preceding citation by the Examiner is totally silent as to applying the presentation metadata to the technical metadata and the business metadata to generate the information catalog, and discloses no such "applying" step. The preceding citation by the Examiner is totally silent about the information catalog comprising the technical metadata and the business metadata in accordance with the presentation format specified by the presentation metadata.

Based on the preceding arguments, Applicant respectfully contends that Myers Jr. does not anticipate claims 1, 11, and 21, and that claims 1, 11, and 21 are in condition for allowance. Since claims 2, 5, 9 and 10 depend from claim 1, Applicants contend that claims 2, 5, 9 and 10 are likewise in condition for allowance. Since claims 12, 15, 19 and 20 depend from claim 11, Applicants contend that claims 12, 15, 19 and 20 are likewise in condition for allowance. Since claims 22, 25, 29 and 30 depend from claim 21, Applicants contend that claims 22, 25, 29 and 30 are likewise in condition for allowance.

35 U.S.C. § 103(a)

The Examiner rejected claims 3, 4, 6-8, 13, 14, 16-18, 23, 24, 26-28 and 31-36 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Myers Jr. *et al.* as applied to claims 1, 2, 5, 9-11, 12, 15, 19, 20-22, 25, 29 and 30 above, in view of the *Microsoft Computer Dictionary Fifth Edition*, Microsoft Press, 2002, hereafter *Microsoft*.

Claims 3, 4, 6-8, 13, 14, 16-18, 23, 24, and 26-28

Since claims 3, 4, and 6-8 depend from claim 1, which Applicants have argued *supra* to not be unpatentable over Myers Jr. under 35 U.S.C. §102(b), Applicants maintain that claims 3, 4, and 6-8 are likewise not unpatentable over Myers Jr. in view of *Microsoft* under 35 U.S.C. §103(a).

Since claims 13, 14, and 16-18 depend from claim 11, which Applicants have argued *supra* to not be unpatentable over Myers Jr. under 35 U.S.C. §102(b), Applicants maintain that claims 13, 14, and 16-18 are likewise not unpatentable over Myers Jr. in view of *Microsoft* under 35 U.S.C. §103(a).

Since claims 23, 24, and 26-28 depend from claim 21, which Applicants have argued *supra* to not be unpatentable over Myers Jr. under 35 U.S.C. §102(b), Applicants maintain that claims 23, 24, and 26-28 are likewise not unpatentable over Myers Jr. in view of *Microsoft* under 35 U.S.C. §103(a).

Claims 31-36

Applicants respectfully contend that claim 31 is not unpatentable over Myers Jr. in view of

Microsoft because Myers Jr. in view of *Microsoft* does not teach or suggest each and every feature of claim 31.

As a first example of why claim 31 is not unpatentable over Myers Jr. in view of *Microsoft*, Myers Jr. in view of *Microsoft* does not teach or suggest the feature: "said method comprising generating the information catalog by applying presentation metadata to technical metadata and business metadata such that the information catalog comprises the technical metadata and the business metadata in accordance with a presentation format specified by the presentation metadata".

With respect to the aforementioned feature in the first example, the Examiner argues: "See e.g. Myers Jr. et al. Fig. 7 where, see Detailed Description par. 35, "the tabs 30 and buttons 31 at the top of the page represent a two-level hierarchical view of the information structure. The tabs 30 represent high level categories. Each tab has a set of buttons 31 or menus providing the next lower level breakdown. The "home" tab 32 contains some of the most basic information categories, such as the "process page" 33, as shown in the body frame" where, see e.g. Myers Jr. et al. Fig. 2 where, see Detailed Description par. 6, "The information transformation services layer 211 acts as a bidirectional link between the user interface and the populated CEE database" and Myers Jr. et al. Fig. 4 where Tools 402 and 404 access "data" in "database 407"".

In response, Applicant respectfully contends that the preceding citation by the Examiner is totally silent as to applying the presentation metadata to the technical metadata and the business metadata such that the information catalog comprises the technical metadata and the business metadata in accordance with a presentation format specified by the presentation metadata, and

discloses no such “applying” step.

As a second example of why claim 31 is not unpatentable over Myers Jr. in view of *Microsoft*, Myers Jr. Jr. in view of *Microsoft* does not teach or suggest the feature: “said technical metadata being associated with data used by computer applications supporting business processes of the business model”.

With respect to the aforementioned feature in the first example, the Examiner argues: “See e.g. Myers Jr. et al. Fig. 4 where, see Brief Summary par. 20, “At the base of the CEE is an object oriented database managing an associative object model (product model) for providing a persistent understanding of product and program information, assets and tools available in the enterprise””.

In response, Applicant respectfully contends that the preceding citation by the Examiner is totally silent about technical metadata being associated with data used by computer applications supporting business processes of the business model.

As a third example of why claim 31 is not unpatentable over Myers Jr. in view of *Microsoft*, Myers Jr. Jr. in view of *Microsoft* does not teach or suggest the feature: “a package list frame, an object list frame driven by the package list frame, and a detail frame driven by the object list frame ... said package list frame comprising means for selecting applications of said computer applications and associated table creators of tables relating to the technical metadata; said object list frame comprising means for selecting tables driven by a computer application and associated table creator selected from the package list frame; said detail frame comprising means

for displaying table information relating to a table selected from the object list frame”.

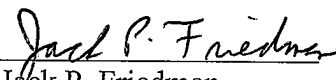
Although the Examiner cites *Microsoft* for displaying contents of one or more HTML documents in frames, the Examiner has not cited any prior art that teaches the specific frames claimed (package list frame, object list frame , detail frame) subjected to the claimed limitations on these specific frames.

Based on the preceding arguments, Applicant respectfully contends that claim 31 is not unpatentable over Myers Jr. in view of *Microsoft*, and that claim 31 is in condition for allowance. Since claims 31-36 depend from claim 31, Applicants contend that claims 31-36 are likewise in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457.

Date: 01/12/2007


Jack P. Friedman
Registration No. 44,688

Schmeiser, Olsen & Watts
22 Century Hill Drive - Suite 302
Latham, New York 12110
(518) 220-1850
E-mail: jfriedman@iplawusa.com